

## Ferenc, Christopher B.

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**From:** McCurdy, Barbara <barbara.mccurdy@finnegan.com>  
**Sent:** Wednesday, May 1, 2019 11:07 AM  
**To:** Ferenc, Christopher B.  
**Cc:** Sodikoff, Brian; Feldstein, Mark; Sommers, Erin; DeRoo, Pier; BMWhite@perkinscoie.com; EGreb@perkinscoie.com  
**Subject:** RE: IPR2019-00789

Counsel:

Patent Owner Biogen agrees that a telephone conference is not required at this time to address Sawai's March 26, April 12, and April 19 correspondence with the Board.

Sawai's statement that it "does not intend to produce its own testifying witnesses or file substantive papers in the Mylan IPR so long as Mylan remains a party to the case" constitutes a new position by Sawai, as Sawai's motion for joinder did not disclaim reliance on Sawai's declarants absent agreement from Mylan. Biogen objects to Sawai taking a new position. Biogen would also object if Sawai were joined and failed to make its declarants available for depositions.

Barbara McCurdy  
Counsel for Patent Owner Biogen MA Inc.

### Barbara Clarke McCurdy

Partner

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## FINNEGAN

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**From:** Ferenc, Christopher B. <christopher.ferenc@kattenlaw.com>  
**Sent:** Thursday, April 25, 2019 4:57 PM  
**To:** Feldstein, Mark <mark.feldstein@finnegan.com>; McCurdy, Barbara <barbara.mccurdy@finnegan.com>; Sommers, Erin <Erin.Sommers@finnegan.com>; DeRoo, Pier <Pier.DeRoo@finnegan.com>; BMWhite@perkinscoie.com; EGreb@perkinscoie.com  
**Cc:** Sodikoff, Brian <brian.sodikoff@kattenlaw.com>  
**Subject:** FW: IPR2019-00789

**EXTERNAL Email:**

Counsel:

Sawai states that "if joined to the Mylan IPR (IPR2018-01403), Sawai does not intend to produce its own testifying witnesses or file substantive papers in the Mylan IPR so long as Mylan remains a party to the case." Sawai will file its Reply in the normal course, and absent hearing otherwise, Sawai plans to indicate in its Reply that it has contacted Mylan but not received a response on the declaration situation.

Furthermore, Sawai has no objection to the panel revisiting the declarant situation should it become an issue when deciding Sawai's Motion for Joinder.

To the extent you have anything to add, please respond to this email.

Best regards,

Chris Ferenc  
Counsel for Sawai USA, Inc. and Sawai Pharmaceuticals, Ltd.

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[christopher.ferenc@kattenlaw.com](mailto:christopher.ferenc@kattenlaw.com) / [www.kattenlaw.com](http://www.kattenlaw.com)

-----Original Message-----

From: Trials <[Trials@USPTO.GOV](mailto:Trials@USPTO.GOV)>  
Sent: Wednesday, April 24, 2019 3:17 PM  
To: Ferenc, Christopher B. <[christopher.ferenc@kattenlaw.com](mailto:christopher.ferenc@kattenlaw.com)>  
Cc: Feldstein, Mark <[mark.feldstein@finnegan.com](mailto:mark.feldstein@finnegan.com)>; McCurdy, Barbara <[barbara.mccurdy@finnegan.com](mailto:barbara.mccurdy@finnegan.com)>; Sommers, Erin <[Erin.Sommers@finnegan.com](mailto:Erin.Sommers@finnegan.com)>; DeRoo, Pier <[Pier.DeRoo@finnegan.com](mailto:Pier.DeRoo@finnegan.com)>; [BMWhite@perkinscoie.com](mailto:BMWhite@perkinscoie.com); [EGreb@perkinscoie.com](mailto:EGreb@perkinscoie.com); Sodikoff, Brian <[brian.sodikoff@kattenlaw.com](mailto:brian.sodikoff@kattenlaw.com)>  
Subject: RE: IPR2019-00789

Counsel:

The panel has received Sawai's Motion for Joinder. The panel understands that, if joined to the Mylan IPR (IPR2018-01403), Sawai does not intend to produce its own testifying witnesses or file substantive papers in the Mylan IPR so long as Mylan remains a party to the case. In this situation, the panel advises Sawai to file its Reply in the normal course, and to indicate in the Reply that it has contacted Mylan but not received a response, if that remains the case. The panel can revisit the matter should the declarant situation become an issue when deciding Sawai's Motion for Joinder. A teleconference is not necessary if the above is agreeable to the parties.

Best regards,  
Eric W. Hawthorne  
Supervisory Paralegal Specialist  
Patent Trial and Appeal Board

-----Original Message-----

From: Ferenc, Christopher B. <[christopher.ferenc@kattenlaw.com](mailto:christopher.ferenc@kattenlaw.com)>  
Sent: Friday, April 19, 2019 7:44 AM  
To: Trials <[Trials@USPTO.GOV](mailto:Trials@USPTO.GOV)>  
Cc: Feldstein, Mark <[mark.feldstein@finnegan.com](mailto:mark.feldstein@finnegan.com)>; McCurdy, Barbara <[barbara.mccurdy@finnegan.com](mailto:barbara.mccurdy@finnegan.com)>; Sommers, Erin <[Erin.Sommers@finnegan.com](mailto:Erin.Sommers@finnegan.com)>; DeRoo, Pier <[Pier.DeRoo@finnegan.com](mailto:Pier.DeRoo@finnegan.com)>; [BMWhite@perkinscoie.com](mailto:BMWhite@perkinscoie.com); [EGreb@perkinscoie.com](mailto:EGreb@perkinscoie.com); Sodikoff, Brian <[brian.sodikoff@kattenlaw.com](mailto:brian.sodikoff@kattenlaw.com)>  
Subject: Re: IPR2019-00789

Dear PTAB,

We represent petitioners Sawai USA, Inc. and Sawai Pharmaceuticals, Ltd. (together "Sawai") in the pending inter partes review, Sawai USA, Inc. and Sawai Pharmaceuticals, Ltd. v. Biogen MA, Inc., IPR2019-00789. As you are aware, Sawai

filed a Motion for Joinder pursuant to 35 U.S.C. § 315(c) and 37 C.F.R § 42.122(b) requesting joinder with a pending inter partes review filed by Mylan Pharmaceuticals, Inc., Mylan Pharmaceuticals, Inc. v. Biogen MA Inc., IPR2018-01403 ("Mylan IPR").

We are following up on the Board's April 12th correspondence (below) requesting Sawai to check back in with the Board regarding Sawai's request for a telephone conference with the Board. It is Sawai's understanding that the panel for IPR2019-00789 would be the same as the Mylan IPR. Thus, Sawai requests a telephone conference between the parties and Judges Snedden, Chagnon and Hawlow, the panel assigned to IPR2018-01403. As explained in Sawai's motion for Joinder in IPR2019-00789 (Paper 2), Sawai seeks Mylan's permission to use the same experts Mylan used in IPR2018-01403. Over the past few weeks, Sawai has made numerous efforts (including emails and voice mails to Mylan's counsel) to get Mylan's position on whether Mylan will allow Sawai to use its experts. Mylan has refused to answer one way or another. (Sawai is willing to provide the PTAB with copies of its email correspondence to counsel for Mylan upon request of the PTAB.)

Sawai requests a conference with Judges Snedden, Chagnon and Hawlow, and asks the panel to Order Mylan to provide its answer. Sawai needs this information so that it can properly respond in its Reply to Patent Owner's Opposition to Motion for joinder. As stated in Sawai's previous emails to the PTAB, during any conference call with the PTAB, Sawai welcomes any additional instructions from the PTAB regarding the Motion for Joinder.

Best regards,

Chris Ferenc  
Counsel for Sawai USA, Inc. and Sawai Pharmaceuticals, Ltd.

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On Apr 12, 2019, at 10:37 AM, Trials <[Trials@uspto.gov](mailto:Trials@uspto.gov)>> wrote:

Counsel: We do not have a panel for this case yet. Please check back this time next week.

Thank you,  
Eric W. Hawthorne  
Supervisory Paralegal Specialist  
Patent Trial and Appeal Board

From: Ferenc, Christopher B. <[christopher.ferenc@kattenlaw.com](mailto:christopher.ferenc@kattenlaw.com)>>  
Sent: Friday, April 12, 2019 10:27 AM  
To: Trials <[Trials@USPTO.GOV](mailto:Trials@USPTO.GOV)>>  
Cc: Feldstein, Mark <[mark.feldstein@finnegan.com](mailto:mark.feldstein@finnegan.com)>>; McCurdy, Barbara <[barbara.mccurdy@finnegan.com](mailto:barbara.mccurdy@finnegan.com)>>; Sommers, Erin <[Erin.Sommers@finnegan.com](mailto:Erin.Sommers@finnegan.com)>>; DeRoo, Pier <[Pier.DeRoo@finnegan.com](mailto:Pier.DeRoo@finnegan.com)>>;

[BMWhite@perkinscoie.com](mailto:BMWhite@perkinscoie.com)<<mailto:BMWhite@perkinscoie.com>>;  
[EGreb@perkinscoie.com](mailto:EGreb@perkinscoie.com)<<mailto:EGreb@perkinscoie.com>>; Sodikoff, Brian  
<[brian.sodikoff@kattenlaw.com](mailto:brian.sodikoff@kattenlaw.com)<<mailto:brian.sodikoff@kattenlaw.com>>>  
Subject: RE: IPR2019-00789

Dear PTAB,

We represent petitioners Sawai USA, Inc. and Sawai Pharmaceuticals, Ltd. (together "Sawai") in the pending inter partes review, Sawai USA, Inc. and Sawai Pharmaceuticals, Ltd. v. Biogen MA, Inc., IPR2019-00789. As you are aware, Sawai filed a Motion for Joinder pursuant to 35 U.S.C. § 315(c) and 37 C.F.R § 42.122(b) requesting joinder with a pending inter partes review filed by Mylan Pharmaceuticals, Inc., Mylan Pharmaceuticals, Inc. v. Biogen MA Inc., IPR2018-01403 ("Mylan IPR").

We are following up on the Board's March 26th correspondence (below) requesting Sawai to check back in with the Board regarding Sawai's request for a telephone conference with the Board. Specifically, Sawai requests a telephone conference between the parties and Judges Snedden, Chagnon and Hawlow, the panel assigned to IPR2018-01403. As explained in Sawai's motion for Joinder in IPR2019-00789 (Paper 2), Sawai seeks Mylan's permission to use the same experts Mylan used in IPR2018-01403. Over the past few weeks, Sawai has made numerous efforts (including emails and voice mails to Mylan's counsel) to get Mylan's position on whether Mylan will allow Sawai to use its experts. Mylan has refused to answer one way or another. (Sawai is willing to provide the PTAB with copies of its email correspondence to counsel for Mylan upon request of the PTAB.)

Sawai requests a conference with Judges Snedden, Chagnon and Hawlow, and asks the panel to Order Mylan to provide its answer. Sawai needs this information so that it can properly respond in its Reply to Patent Owner's Opposition to Motion for joinder. As stated Sawai's email to the PTAB on March 26th, during any conference call with the PTAB, Sawai welcomes any additional instructions from the PTAB regarding the Motion for Joinder.

Best regards,

Chris Ferenc  
Counsel for Sawai USA, Inc. and Sawai

Christopher B. Ferenc  
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<https://gcc01.safelinks.protection.outlook.com/?url=www.kattenlaw.com&data=02%7C01%7Ctrials%40uspto.gov%7C8fddc872b152437f296708d6c4bc5ec6%7Cff4abfe983b540268b8ffa69a1cad0b8%7C1%7C0%7C636912710666330595&data=5s2vnxGbfc8ozsYtlv2f8kwarCq5y8%2BQ6s1TE%2FpfUKQ%3D&reserved=0><<https://gcc01.safelinks.protection.outlook.com/?url=http%3A%2F%2Fwww.kattenlaw.com&data=02%7C01%7Ctrials%40uspto.gov%7C8fddc872b152437f296708d6c4bc5ec6%7Cff4abfe983b540268b8ffa69a1cad0b8%7C1%7C0%7C636912710666340599&data=Tr08HDJ%2Fme67ferRwLvcGaQyBPAKERRYkB1pnKZ2Q%3D&reserved=0>>

From: Trials <[Trials@USPTO.GOV](mailto:Trials@USPTO.GOV)<<mailto:Trials@USPTO.GOV>>>

Sent: Tuesday, March 26, 2019 12:46 PM

To: Ferenc, Christopher B. <[christopher.ferenc@kattenlaw.com](mailto:christopher.ferenc@kattenlaw.com)<<mailto:christopher.ferenc@kattenlaw.com>>>; Trials <[Trials@USPTO.GOV](mailto:Trials@USPTO.GOV)<<mailto:Trials@USPTO.GOV>>>

Cc: Feldstein, Mark <[mark.feldstein@finnegan.com](mailto:mark.feldstein@finnegan.com)<<mailto:mark.feldstein@finnegan.com>>>; McCurdy, Barbara <[barbara.mccurdy@finnegan.com](mailto:barbara.mccurdy@finnegan.com)<<mailto:barbara.mccurdy@finnegan.com>>>; Sommers, Erin <[Erin.Sommers@finnegan.com](mailto:Erin.Sommers@finnegan.com)<<mailto:Erin.Sommers@finnegan.com>>>; DeRoo, Pier <[Pier.DeRoo@finnegan.com](mailto:Pier.DeRoo@finnegan.com)<<mailto:Pier.DeRoo@finnegan.com>>>;  
[BMWhite@perkinscoie.com](mailto:BMWhite@perkinscoie.com)<<mailto:BMWhite@perkinscoie.com>>;

[EGreb@perkinscoie.com](mailto:EGreb@perkinscoie.com)<<mailto:EGreb@perkinscoie.com>>; Sodikoff, Brian  
<[brian.sodikoff@kattenlaw.com](mailto:brian.sodikoff@kattenlaw.com)<<mailto:brian.sodikoff@kattenlaw.com>>>

Subject: RE: IPR2019-00789

Counsel: We do not have a panel for this case yet. Please check back in a couple of weeks.  
Thank you,

Maria King  
Deputy Chief Clerk for Trials  
Patent Trial and Appeal Board  
U.S. Patent and Trademark Office  
703-756-1288

From: Ferenc, Christopher B. <[christopher.ferenc@kattenlaw.com](mailto:christopher.ferenc@kattenlaw.com)<<mailto:christopher.ferenc@kattenlaw.com>>>  
Sent: Tuesday, March 26, 2019 12:32 PM  
To: Trials <[Trials@USPTO.GOV](mailto:Trials@USPTO.GOV)<<mailto:Trials@USPTO.GOV>>>  
Cc: Feldstein, Mark <[mark.feldstein@finnegan.com](mailto:mark.feldstein@finnegan.com)<<mailto:mark.feldstein@finnegan.com>>>; McCurdy, Barbara  
<[barbara.mccurdy@finnegan.com](mailto:barbara.mccurdy@finnegan.com)<<mailto:barbara.mccurdy@finnegan.com>>>; Sommers, Erin  
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[BMWhite@perkinscoie.com](mailto:BMWhite@perkinscoie.com)<<mailto:BMWhite@perkinscoie.com>>;  
[EGreb@perkinscoie.com](mailto:EGreb@perkinscoie.com)<<mailto:EGreb@perkinscoie.com>>; Sodikoff, Brian  
<[brian.sodikoff@kattenlaw.com](mailto:brian.sodikoff@kattenlaw.com)<<mailto:brian.sodikoff@kattenlaw.com>>>  
Subject: IPR2019-00789

Your Honors:

We represent petitioners Sawai USA, Inc. and Sawai Pharmaceuticals, Ltd. (together "Sawai") in the pending inter partes review, Sawai USA, Inc. and Sawai Pharmaceuticals, Ltd. v. Biogen MA, Inc., IPR2019-00789. As you are aware, Sawai filed a Motion for Joinder pursuant to 35 U.S.C. § 315(c) and 37 C.F.R § 42.122(b) requesting joinder with a pending inter partes review filed by Mylan Pharmaceuticals, Inc., Mylan Pharmaceuticals, Inc. v. Biogen MA Inc., IPR2018-01403 ("Mylan IPR").

All parties are in the process of setting up a meet and confer to discuss Sawai's pending joinder motion. Ahead of the meet and confer, Sawai wanted to know if the panel had any additional instructions regarding the Motion for Joinder that the parties should discuss during any meet and confer.

Counsel for all parties has been copied on this email and were provided a copy for prior consideration. Without further elaboration, (only) counsel for Biogen responded as follows: "Biogen believes that Sawai's proposed email to the Board is improper at this time."

Best regards,

Chris Ferenc  
Counsel for Sawai USA, Inc. and Sawai Pharmaceuticals, Ltd.

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